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10/617,524	07/10/2003	Craig Fellenstein	AUS920030255US1	3552

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EXAMINER	
LIN, SHEW FEN	

ART UNIT	PAPER NUMBER
2166	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/617,524	FELLENSTEIN ET AL.	
	Examiner	Art Unit	
	Shew-Fen Lin	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-9,11,12,14,18,20,21,23-29 and 31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-9,11,12,14,18,20,21,23-29 and 31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6/12/06* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

a. This action is taken to response to amendments and remarks filed on January 1, 2006.

b. Claims 1, 3-9, 11-12, 14, 18, 20-21, 23-29 and 31 are pending and claims 2, 10, 13, 15-17, 19, 22 and 30 have been cancelled. Claims 1 and 18 are independent claims.

Drawings

The drawing is objected to because it fails to show the necessary textual labels of features or symbols in Figure 2 as described in the specification. Further, it is confusing to have two labels of "Yes" associated with the decision block (item 24).

Claim Objections

Independent claims 1 and 18 both recite a "whether" statement, which suggests an optionally, passive recitation. In order to have the remaining limitations after the "whether" statement fully considered and given complete patentable weight, the "whether" recitation should be changed to a definite language. Since the result of "whether" can be True or False, the remaining limitations may or may not happen (i.e. marking an entry having an identifier that matches the file identifier). Appropriate correction is required.

All the dependent claims that have the similar language (whether) have the same deficiency and appropriate correction is required.

Withdrawal of Rejections/Objections

Applicants' amendments overcome the 112 rejection and claim objections. Examiner hereby withdraws the rejection/objections that were given in the previous Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3,4,5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3,4,5 recite the limitation "any marked entries", and there is insufficient antecedent basis for this limitation in the claim. This is because, claims 3,4,5 recite the additional steps after "said match determination step" of claim 1, but there is no marked entries at or before the recited "said match determination step" in the claim 1.

Response to Amendment and Remarks

Applicants's amendments and remarks have been fully and carefully considered but they are not deemed to be persuasive.

Applicants contends that Hung does not teach the limitation of "marking an entry having an identifier that matches the file identifier; and determining whether there are more entries in the index to compare with the identifier of the file to be stored;" because Hung does not provide

"the situation when more than one folder matches the description of the message to be stored" and "marking the entries in the table". The Examiner respectfully disagrees.

First, as pointed out by the Applicants that Hung discloses looking to the first match when there are multiple matches (column 10, lines 7-15). This clearly teaches "the situation when more than one folder matches the description of the message to be stored".

Second, it is noted that the limitations that anchored Applicants's argument (i.e., when multiple folders match the search criteria, folders in the index that match the search criteria are initially marked) are not recited in the rejected claim(s). Claims 1 and 18 recite, "marking an entry having an identifier that matches the file identifier". Since no iteration or looping is recited in the claims to identify multiple matches, it is logical for person skilled in the art to assume that there is only one occurrence of match as entry point. Therefore, Hung's teaching of selecting a folder would meet the limitation recited in the claims.

Applicants contends there is no prima facie case for obviousness to combine Hung and Binning because in Binning's teaching the search information is for retrieving information and not for determining a location to store information. The Examiner respectfully disagrees.

First, it is inherent that the information must be located first before it can be stored or retrieved. Second, a storage system always involves read (retrieve) and write (store). The Examiner relies on Binning to teach searching storage location (folder/directory), for a storage system, a search method can be equally applied to read/write (retrieve/store). It is obvious for any persons with ordinary skill at the time of invention to improve the teaching of Hung by using search method as suggested by Binning to better identify the storage location. A *prima facie case of obviousness* is established when the teachings from the prior art itself would appear to have

suggested the claimed subject matter to a person of ordinary skill in the art. Once such a case is established, it is incumbent upon appellant to go forward with objective evidence of unobviousness. In re Fielder, 471 F.2d 640, 176 USPQ 300 (CCPA 1973).

Therefore, the Examiner's stance regarding the status of claims 1 and 18, and all those claims depending on it, remains the same as stated in the previous Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6-9, 11, 14, 18, 23-26, 28, and 31 are ejected under 35 U.S.C. 102(e) as being anticipated by Hung (US Patent 6,772,143).

As to claims 1 and 18, Hung discloses a system with methods /means / system for predicting the storage location of file (automatic store and organize message files, column 1, lines 31-38) comprising the steps of:

retrieving an identifier for the file for which predictive storage is desired (message-filter expression as identifier, Figure 3, item 32, column 3, lines 35-37, column 4, lines 18-26);

comparing the retrieved identifier with a set of file storage locations in a storage index (compare expression with folder. Figure 3, item 34, column 3, lines 37-39, column 10, lines 1-7);

creating an initial storage index wherein each storage location entry in the index has a predetermined identifier (auto file rule is defined for folders, column 7, lines 40-45);

determining whether there is a match between a retrieved identifier and a storage location from the storage index (check the matching between expression and folder, Figure 3, item 34, column 3, lines 37-39, column 10, lines 9-13);

marking a storage entry having an identifier that matches the file identifier (query the table of folder to mark the match between message and expression, column 10, lines 9-13);

determining whether there are more storage entries in the index to compare with the identifier of the file to be stored (compare with folder in the table, column 10, lines 16-29); and

storing the file in the storage location matching the retrieved storage identifier (store the file in the folder when message satisfies the expression for the folder, Figure 3, item 36, column 3, lines 39-40, column 10, lines 44-47).

As to claims 6 and 23, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; after said match determination step, the steps of:

determining whether there are any marked entries, when there is a determination that there are no more entries in the index to compare with the file identifier (check if there is match between message and folder, column 10, lines 16-29); and

creating a new storage location in which to store the file when there is a determination that there are no entries matching the file identifier (create new folder if no match was found, column 10, lines 47-51).

As to claims 7 and 24, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; the step of adding the newly created storage location to the storage location index (add new folder to folder table, column 10, lines 47-51).

As to claims 8 and 25, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; wherein said match determination step further comprises the step of determining whether there are more entries in the index when there is a determination that there is not a match between the file identifier and an entry in the index (if there is no match between message and folder expression, then proceed to next folder expression, if any, column 10, lines 23-29).

As to claims 9 and 26, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; the step of retrieving the next entry from the index when there is a determination that there are more entries in the storage location index and returning to said comparison step (if there is no match between message and folder expression, then proceed to next folder expression, if any, column 10, lines 23-29).

As to claims 11 and 28, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; after said match determination step, the steps of:

marking a storage location entry that matches the file identifier (query the table of folder to mark the match between message and expression, column 10, lines 9-13);

determining whether there are more entries in the index to compare with the identifier of the file (compare with folder in the table, column 10, lines 16-29);

determining whether there are any marked entries, when there is a determination that there are no more entries in the index to compare with the file identifier (check if there is match between message and folder, column 10, lines 16-29); and

storing the file to a default storage location when there is a determination that there are no entries matching the file identifier (column 8, lines 57-59).

As to claims 14 and 31, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; before said identifier retrieval step, the step of determining whether there is an activated user override and storing the file as designated by the user when there is a determination of an active user override (user can select folder to store message, column 9, lines 1-7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3, 12, 20, 27, and 29 are rejected under 35 U.S.C. 103(a) as being obvious over Hung as applied to claims 1 and 18 as noted above, and further in view of Bhide (US Patent 6,564,214).

As to claims 3 and 20, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; after said match determination step, the steps of:

determining whether there are any marked entries, when there is a determination that there are no more entries in the index to compare with the file identifier (check if there is match between message and folder, column 10, lines 16-29);

determining whether there is more than one entry matching the file identifier, when there is a determination that there are marked entries in the index (column 10, lines 12-16); and

storing the file in the storage location with the matching identifier when there is only one storage entry matching the file identifier.

Hung discloses the elements of claims 3 and 20 as noted above but does not explicitly disclose storing the file in the storage location with the matching identifier when there is only one storage entry matching the file identifier.

Bhide discloses unique match string (identifier) with lookup search (Figure 3, column 5, lines 26-30). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Hung's disclosure to include selecting a unique match folder to store file as taught by Bhide for the purpose of permitting more accurate and meaningful association the storage location and file to be stored (column 4, lines 41-43, Bhide). The skilled artisan would have been motivated to improve the invention of Hung per the above such that storage location can be uniquely identified (Figure 4, item 230, Bhide).

As to claim 27, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; wherein said match determination step further comprises the steps of:

determining whether there are more entries in the index when there is a determination that there is not a match between the file identifier and an entry in the index;

determining whether there are any marked entries, when there is a determination that there are no more entries in the index to compare with the file identifier (check if there is match between message and folder, column 10, lines 16-29);

determining whether there is more than one entry matching the file identifier, when there is a determination that there are marked entries in the index (column 10, lines 12-16); and

storing the file in the storage location with the matching identifier when there is only one storage location entry matches the file identifier.

Hung discloses the elements of claim 27 as noted above but does not explicitly disclose storing the file in the storage location with the matching identifier when there is only one storage entry matching the file identifier.

Bhide discloses unique match string (identifier) with lookup search (Figure 3, column 5, lines 26-30). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Hung's disclosure to include selecting a unique match folder to store file as taught by Bhide for the purpose of permitting more accurate and meaningful association the storage location and file to be stored (column 4, lines 41-43, Bhide). The skilled artisan would have been motivated to improve the invention of Hung per the above such that storage location can be uniquely identified (Figure 4, item 230, Bhide).

As to claims 12 and 29, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; after said match determination step, the steps of:

marking a storage location entry that matches the file identifier (query the table of folder to mark the match between message and expression, column 10, lines 9-13);

determining whether there are more entries in the index to compare with the identifier of the file (compare with folder in the table, column 10, lines 16-29);

determining whether there are any marked entries, when there is a determination that there are no more entries in the index to compare with the file identifier (check if there is match between message and folder, column 10, lines 16-29); and

retrieving a next file identifier and a next matching entry and returning to said comparison step, when there is a determination that there are no storage entry identifiers matching the file identifier (more complex expression can be used, like conditional/or, column 10, lines 30-34).

Hung discloses the elements of claims 12 and 29 as noted above but does not explicitly disclose retrieving a next file identifier and a next matching entry and returning to said comparison step, when there is a determination that there are no storage entry identifiers matching the file identifier.

Bhide discloses using different string for matching when there is no match found using first string (identifier) for lookup search (Figure 4, item 240, column 5, lines 44-52). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Hung's disclosure to use second string (identifier) for matching as taught by Bhide for the purpose of permitting more accurate and meaningful association the storage location and file to be stored (column 4, lines 41-43, Bhide). The skilled artisan would have been motivated to improve the invention of Hung per the above such that storage location can be uniquely identified (Figure 4, item 230, Bhide).

Claims 4-5 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Hung as applied to claims 1 and 18 as noted above, and further in view of Binning et al. (US Publish 2004/0214554, hereinafter referred as Binning).

As to claims 4 and 21, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; after said match determination step, the steps of:

determining whether there are any marked entries, when there is a determination that there are no more entries in the index to compare with the file identifier (check if there is match between message and folder, column 10, lines 16-29);

determining whether there is more than one entry matching the file identifier, when there is a determination that there are marked entries in the index (column 10, lines 12-16);

retrieving a next file identifier when there is determination of more than one marked entry in the index; and returning to said comparison step.

Hung discloses the elements of claims 4 and 21 as noted above but does not explicitly disclose retrieving a next file identifier when there is determination of more than one marked entry in the index; and returning to said comparison step.

Binning discloses changing the search terms or by adding more search terms (next identifier) when there is more than one match (Figure 5, paragraph [0036], paragraph [0037]). It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Hung's disclosure to use second identifier to search storage location as taught by Binning for the purpose of narrowing the search and permitting more accurate and meaningful

association the storage location and file to be stored (paragraph [0042], lines 10-15, Binning). The skilled artisan would have been motivated to improve the invention of Hung per the above such that storage location can be uniquely identified (Figure 5, item 516, Binning).

As to claim 5, Hung discloses the elements of claims 1 and 18 as noted above and furthermore; after said match determination step, the steps of:

retrieving a next file identifier and a next entry identifier for a marked entry; and returning to said comparison step.

Hung discloses the elements of claim 5 as noted above but does not explicitly disclose retrieving a next file identifier when there is determination of more than one marked entry in the index; and returning to said comparison step.

Binning discloses changing the search terms or by adding more search terms (next identifier) when there is more than one match (Figure 5, paragraph [0036], paragraph [0037]).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Hung's disclosure to use second identifier to search storage location as taught by Binning for the purpose of narrowing the search and permitting more accurate and meaningful association the storage location and file to be stored (paragraph [0042], lines 10-15, Binning). The skilled artisan would have been motivated to improve the invention of Hung per the above such that storage location can be uniquely identified (Figure 5, item 516, Binning).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Shew-Fen Lin
Patent Examiner SFL

Art Unit 2166
September 28, 2006

MOHAMMAD ALI
PRIMARY EXAMINER